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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,469	07/15/2004	Shin Aihara	254785US0PCT	5141
22850 7590 12/21/2006 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER DELCOTTO, GREGORY R	
			ART UNIT 1751	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/21/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

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Office Action Summary

Application No.

10/500,469

Applicant(s)

AIHARA ET AL.

Examiner

Gregory R. Del Cotto

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 11/27/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 12-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 12-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/27/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 3 and 12-16 are pending. Claims 1, 2, and 4-11 have been canceled. Applicant's arguments and amendments filed 10/26/06 have been entered.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/27/06 has been entered.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 7/27/06 have been withdrawn:

The objection to the specification as failing to contain an abstract has been withdrawn.

The objection to claims 1-11 due to minor informalities has been withdrawn.

The rejection of claims 1-3, 5, 6, and 8-10 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jeschke et al (US 6,251,849) has been withdrawn.

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The rejection of claims 1-11 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP-2001-271094 has been withdrawn.

The rejection of claims 1-3, 5, 6, and 8-11 under 35 U.S.C. 102(e) as being anticipated by Aubay et al (6,593,288) has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3 and 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jeschke et al (6,251,849) in view of Pucci et al (US 5,872,088) and Aubay et al (US 6,703,358).

Jeschke et al teach the use of water-based cleaners for hard surfaces containing from 0.01 to 10% by weight of cationic polymers containing monomer units having the same formula as recited by the instant claims, and 0.1 to 50% by weight of one or more nonionic surfactants. See column 2, line 30 to column 3, line 15. Additionally, the cleaning compositions may contain auxiliaries such as solvents in ethanol, isopropanol, glycol ether, etc. See column 4, lines 50-69. In one embodiment, the cleaner is formulated as a ready-to-use solution which may be used as a spray cleaner. The cleaners are suitable as both multipurpose cleaners and as manual dishwashing detergents. The cleaners are particularly suitable for cleaning hard surfaces such as enamel, glass, china, linoleum, ceramic tiles, marble, metals, etc. See column 5, lines 55-69.

Specifically, Jeschke et al teach a bath cleaning composition in the mildly acidic range containing 3.85% of a C8-C10 alkyl polyglucoside, 1% of a C12-C14 fatty alcohol ether having 6 moles of EO, 1% sodium hydroxide, 1% ethanol, 0.3% of various polymers which contain the same monomers as recited by the instant claims, 0.2% preservative, 0.9% perfume oil and the balance water.

Jeschke et al do not teach the specific molecular weight of the polymer as recited by the instant claims or a method of antifouling and washing hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the

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other requisite components of the composition in the specific proportions as recited by the instant claims.

Aubay et al teach a cleaning composition for hard surfaces including ceramic, tile or glass-type comprising at least one surfactant and a water soluble or water-dispersible copolymer. See Abstract and column 1, lines 1-5. The copolymer according to the invention advantageously has a weight-average molecular mass of at least 1000 up to 10,000,000. See column 3, lines 1-10. The composition may also be used for cleaning toilet bowls and includes from 0.05% to 5% by weight of a water-soluble or water-dispersible copolymer, from 0.1 to 40% by weight of an inorganic acid cleaning agent, from 0.5 to 10% by weight of a surfactant, from 0.1 to 3% by weight of a thickener, and additives. See claim 6.

Pucci et al teach hard surface cleaning compositions which are viscous but at the same time easy to rinse. Such compositions are formulated by using a linear C6-C16 alcohol and/or linear alkoxyated C6-C16 alcohol, a hydrotropic solvent, and an anionic surfactant. See Abstract. An advantage of the viscous compositions is that they may be used in a wide range of applications in bathrooms, kitchens, floors, and especially on any vertical surface like walls, toilet bowls, and the like. See column 2, lines 5-15. The compositions of the present invention comprise from 0.1% to 20% by weight of the total compositions of said linear alcohol. See column 3, lines 30-40.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use a specific cationic polymer having the same molecular weight as recited by the instant claims in the composition taught by Jeschke et al, with a

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reasonable expectation of success, because Aubay et al teach the use of a similar cationic polymer having the same molecular weight as recited by the instant claims in a similar hard surface cleaning composition, and further Jeschke et al teach the use of cationic polymers in general which would optimally have such a molecular weight for soil release properties.

Additionally, note that, the Examiner asserts that the teachings of Jeschke et al in combination with Aubay et al suggest compositions having the same antifouling properties as recited by the instant claims because Jeschke et al in combination with Aubay et al suggest compositions containing the same components in the same proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the composition as taught by Jeschke et al to clean toilet bowls, with a reasonable expectation of success, because Aubay et al or Pucci et al teach the use of a similar composition for cleaning hard surfaces in general including toilet bowls, ceramic, etc., and further, Jeschke et al teach the cleaning of hard surfaces in general which would encompass toilet bowls.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to antifoul and wash hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of Jeschke et al in combination with Aubay et al or Pucci et al suggest a method of

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antifouling and washing hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 3 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aubay et al (6,593,288) in view of Pucci et al (US 5,872,088) or Aubay et al (US 6,703,358).

'288 teaches the use of a water-soluble or water-dispersible copolymer comprising monomers including dimethyldiallylammonium chloride, at least one hydrophilic monomer, and optionally at least one hydrophilic monomer compound containing ethylenic unsaturation and of neutral charge, on hard surfaces to give a hard surface hydrophilic properties. See Abstract. The copolymer preferably has a molecular weight of at least 1000, advantageously of at least 10,000. See column 3, lines 35-45. The copolymers are used in compositions for cleaning ceramics such as bathrooms, sinks, shower walls, toilet pans, etc. See column 5, lines 40-55. The polymers containing DADMAC have hydrophilic properties to give the hard surface long-lasting hydrophilic properties so as to avoid the subsequent presence of marks due in particular to the drying of droplets of water deposited on said surface. See column 1, lines 5-15. Additionally, the compositions contain surfactants. See column 11, lines 50-65. Specifically, '288 teaches a detergent formulation for cleaning hard surfaces such as tiles, sinks, baths, etc. containing 24% sodium sulfonate, 5% ethoxylated C12 fatty alcohol, 4% ethanol, polymer, and water. Note that, the Examiner asserts that the teachings of '288 suggest compositions having the same antifouling properties as

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recited by the instant claims because '288 suggest compositions containing the same components in the same proportions as recited by the instant claims.

'288 does not teach a method of antifouling and washing hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Pucci et al and '358 are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the composition as taught by '288 to clean toilet bowls, with a reasonable expectation of success, because '358 or Pucci et al teach the use of a similar composition for cleaning hard surfaces in general including toilet bowls and further, '288 teaches the cleaning of bathroom hard surfaces in general which would encompass toilet bowls.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to antifoul and wash hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '288 in combination with '358 or Pucci et al suggest a method of antifouling and washing hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 3 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pucci et al (US 5,872,088) or Aubay et al (US 6,703,358), both in view of Aubay et al (US 6,593,288).

Pucci et al or '358 are relied upon as set forth above. However, neither reference teaches the use of the specific polymer or a method of cleaning a toilet bowl using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to use the specific polymer containing DADMAC monomer in the composition taught by Pucci et al or '358, with a reasonable expectation of success, because '288 teaches the advantageous non-spotting properties imparted to a similar hard surface cleaning composition when using the specific polymer containing DADMAC monomer, and further, such non-spotting properties would be aesthetically desirable for toilet bowl cleaning compositions as taught by Pucci et al or '358.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to antifoul and wash hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because the broad teachings of '358 or Pucci et al, both in combination with '288 suggest a method of antifouling and washing hard surfaces of toilet bowls using a composition containing the specific

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cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3 and 12-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5, 6, 8, and 9 of copending Application No. 10/500859. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 5, 6, 8, and 9 encompass the material limitations of the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to antifoul and wash hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite

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components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success, because claims 5, 6, 8, and 9 of 10/500859 suggest a method of antifouling and washing hard surfaces of toilet bowls using a composition containing the specific cationic polymer, surfactant, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

With respect to Jeschke et al and Aubay et al, Applicant states that neither reference teaches or suggest a specific method of antifouling or cleaning toilet bowls as not recited by the instant claims. In response, note that, a new ground of rejection has been made, as set forth above, in which the teachings of Jeschke et al and Aubay et al have been combined with secondary references to show that it would have been obvious to one skilled in the art to use the compositions as disclosed by Jeschke et al or Aubay et al for cleaning toilet bowls as recited by the instant claims.

Conclusion

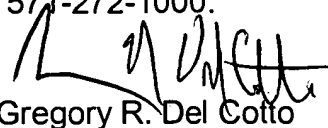
2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Remaining references cited but not relied upon are considered to be cumulative to or less pertinent than those relied upon or discussed above.

Applicant is reminded that any evidence to be presented in accordance with 37 CFR 1.131 or 1.132 should be submitted before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gregory R. Del Cotto
Primary Examiner
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